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# LOWE HAUPTMAN GILMAN & BERNER, LLP

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## Fax Coversheet

# OFFICIAL

<b>To:</b>	Examiner Brian Gordon	<b>From:</b>	Henry Zykorie	<b>FAX RECEIVED</b>
		<b>Date:</b>	June 6, 2003	<b>JUN 09 2003</b>
<b>Fax:</b>	(703) 305-3014	<b>Pages:</b>	_5_ (including cover sheet)	
<b>Re:</b>	U.S. Patent Application 09/598,890 For: SUPPLY ELEMENT FOR A LABORATORY MICROCHIP Inventor: Manfred BERNDT Your Reference: 09/598,890 Our Reference: 4481-022			

☐ Urgent

☐ For Review

☐ Please Comment

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## JUN 10 2003

## TC 1700

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*D. Lawrence*  
 #18  
 6.11.03

Docket No.: 4481-022

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
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In re Application of

Manfred BERNDT

Serial No. 09/598,890

Filed: June 22, 2000

: Group Art Unit: 1743

: Examiner: Brian Gordon

For: SUPPLY ELEMENT FOR A LABORATORY MICROCHIP

**PETITION UNDER 37 CFR 1.144 TO REVIEW AND  
 WITHDRAW IMPROPER RESTRICTION REQUIREMENT**

Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

Sir:

The above-captioned application initially had apparatus claims. Method claims 32-46 and 51-55 were added by the October 25, 2002 Supplemental Amendment and January 8, 2003 Second Supplemental Amendment.

In the January 14, 2003 Final Office Action, the Examiner withdrew the added method claims 32-46 and 51-55 from consideration as being directed to an invention that is independent or distinct from the invention originally claims for the reason that the method does not require the specific identical structure of the apparatus claims. Specifically, the Examiner argued that the method does not require that the first and second supplier be an element of the microchip and therefore the first and second supplier can be any elements such as a pipette, dropper, or any other means.

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In response thereto, and Amendment After Final was submitted to the U.S. Patent and Trademark Office on May 14, 2003. In that Amendment After Final, the method claims were amended to know specifically recite that the first and second supplier were elements of the microchip. Accordingly, as argued in the aforementioned May 14, 2003 Amendment After

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**Serial No. 09/598,890**

Final, the method claims have been amended so as to now be fully commensurate with the apparatus claims and accordingly, it is respectfully request that these claims be considered along with the apparatus claims.

In response to the May 14, 2003 Amendment After Final, an Advisory Action was issued on May 27, 2003. In that Advisory Action, the Amendment After Final was not entered as raising new issues that would require further consideration and/or search and as not placing the application in a better form for appeal by materially reducing or simplifying the issues for appeal. More specifically, with regard to claims 32-46 and 51-55, the Examiner argued that the claims have not previously been considered and now any consideration of the claims would require the consideration of methods not previously searched.

In view of the above, it is respectfully requested that the Examiner's withdrawal of method claims 32-46 and 51-55 from consideration be reversed for the following reasons:

The added method claims corresponded to the apparatus claims. In response to the Examiner's arguments with regard to the first and second supplier not being elements of the microchip, the method claims were revised by the May 14, 2003 Amendment After Final so as to now recite that the first and second supplier are elements of the microchip, thereby overcoming the Examiner's reason for withdrawing method claims 32-46 and 51-55 from consideration.

Since amended method claims 32-46 and 51-55 are fully commensurate with the previously searched apparatus claims, it is submitted that, contrary to the Examiner's arguments, no new consideration of methods not previously searched are needed.

The Examiner, in the May 27, 2003 Advisory Action, correctly noted that there were clerical errors in the presentation of the marked up amended claims. A Substitute Amendment After Final will be submitted shortly. The Substitute Amendment After Final will correspond

Serial No. 09/598,890

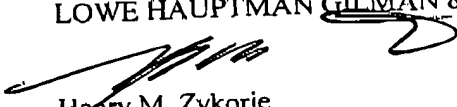
identically to the previously submitted Amendment After Final but with the inadvertent clerical errors corrected.

Since the specific reason for withdrawing method claims 32-46 and 51-55 has been overcome by the revisions to these claims contained within the Amendment After Final and since, as noted above, it is submitted that no new consideration of methods not previously searched are needed, it is respectfully requested that the Examiner's withdrawal of method claims 32-46 and 51-55 from consideration be reversed.

To the extent necessary, please charge any shortage in fee due in connection with this filing to Deposit Account No. 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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